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Date: September 19, 2006

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

GROUP ART UNIT: 3628

EXAMINER: FRANTZY POINVIL

In re application of: Edward G.)
McLaughlin and Flint A Lane)
Application No: 09/277,189)
Filed: March 26, 1999)
Attorney Docket No.: 7196-RCE)

For: SYSTEM AND METHOD FOR
MANAGING MAIL/BILLS
THROUGH A CENTRAL
LOCATION

Commissioner for Patents
MAIL STOP APPEAL BRIEF-PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

September 19, 2006

APPEAL BRIEF

Sir:

Appellants, pursuant to 37 C.F.R. § 41.37, hereby file this Appeal Brief as part of the appeal on the above-referenced patent application.

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I. Real Party in Interest

The real party in interest in this application is Metavante Corporation, the recorded assignee of the entire title of the subject application.

II. Related Appeals and Interferences

There are no other related appeals or interferences.

III. Status of the Claims

Claims 1-30 are pending in the case, and are all finally rejected. Claims 1-30 are the subject of this appeal, and a copy of these claims is attached hereto as the Claims Appendix.

IV. Status of Amendments

An October 17, 2003, amendment to the claims (Amendment D) was the last amendment to be made to the claims, and was entered and considered. There was no post-final rejection amendment, leaving Claims 1-30 pending.

V. Summary of Claimed Subject Matter

Six independent claims (together with claims dependent thereupon) directed toward a method and system for electronically presenting bills are involved in this appeal: Claims 1, 9, 13, 16, 24, and 28. Appellants regard as their invention a method and system for electronically presenting bills which are capable of accepting and processing paper bills which are received from billers on behalf of customers by a service provider. Paper bills are converted into electronic bills by scanning them into electronic

images and extracting billing information from the electronic images. The billing information which is so extracted is then validated. The extracted and validated billing information is then presented to the customer. The present invention provides a unique electronic bill presentment method and system which are capable of dealing with paper bills generated by goods or service providers and presenting these bills to customers electronically, optionally together with bills which are generated by goods or service providers as electronic bills. As such, the system of the present invention is advantageous over prior art bill presentment systems capable of presenting only bills supplied by billers as electronic bills.

A concise explanation of the subject matter defined in each of these six independent claims will be described below, together with references to the specification of the application as filed by page and line numbers, and to the drawings by reference numerals.

Claim 1. Claim 1 is directed to "[a] method of electronically presenting bills for at least one customer having an account from which funds may be drawn." The method is primarily shown in Figs. 4 and as illustrated in the screenshots of Figs. 5-7, and discussed in the specification from page 21, line 21 to page 23, line 10, with the system used to implement the method being further shown in Figs. 2 and 3 and is discussed in the specification from page 14, line 18 to page 21, line 20.

Claim 1, Paragraph 1 (lines 3-4). This step is described in the specification on page 15, lines 13-21 and with reference to Fig. 3.

Claim 1, Paragraph 2 (lines 5-7). This step is described in the specification on page 18, lines 1-10 and with reference to Fig. 3.

Claim 1, Paragraph 3 (lines 8-9). This step is described in the specification on page 16, lines 10-18 and with reference to Fig. 3.

Claim 1, Paragraph 4 (line 10). This step is described in the specification on page 17, lines 9-23 and with reference to Fig. 3, and also with respect to step 410 of Fig. 4 which is described in the specification on page 18, lines 11-18.

Claim 1, Paragraph 5 (line 11). This step is shown with respect to step 415 of Fig. 4 which is described in the specification on page 18, lines 14-16.

Claim 1, Paragraph 6 (lines 12-13). This step is shown with respect to steps 425 and 440 of Fig. 4 which is described in the specification on page 18, lines 16-18.

Claim 1, Paragraph 7 (line 14). This step is shown with respect to steps 450 and 460 of Fig. 4 which is described in the specification on page 18, line 19 to page 19, line 12.

Claim 1, Paragraph 8 (lines 15-16). This step is shown with respect to step 470 of Fig. 4 which is described in the specification on page 18, line 19 to page 19, line 4 and page 19, line 13 to page 20, line 6.

Claim 1, Paragraph 9 (line 17). This step is shown with respect to steps 480 and 485 of Fig. 4 which is described in the specification on page 20, lines 7-10.

Claim 1, Paragraph 10 (lines 19-20). This step is shown with respect to Fig. 5 which is described in the specification on page 21, line 21 to page 22, line 10.

Claim 9. Claim 9 is directed to "[a] method of electronically presenting and paying paper-based bills for at least one customer having an account from which funds may be drawn." The method is primarily shown in Figs. 4 and as illustrated in the screenshots of Figs. 5-7, and discussed in the specification from page 21, line 21 to page 23, line 10, with the system used to implement the method being further shown in Figs. 2 and 3 and is discussed in the specification from page 14, line 18 to page 21, line 20.

Claim 9, Paragraph 1 (line 4). This step is described in the specification on page 17, lines 9-23 and with reference to Fig. 3, and also with respect to step 410 of Fig. 4 which is described in the specification on page 18, lines 11-18.

Claim 9, Paragraph 2 (line 5). This step is shown with respect to step 415 of Fig. 4 which is described in the specification on page 18, lines 14-16.

Claim 9, Paragraph 3 (lines 6-7). This step is shown with respect to steps 425, 440, 450, and 460 of Fig. 4 which is described in the specification on page 18, lines 16 to page 19, line 12.

Claim 9, Paragraph 4 (lines 8-10). This step is shown with respect to step 470 of Fig. 4 which is described in the specification on page 18, line 19 to page 19, line 4 and page 19, line 13 to page 20, line 6.

Claim 9, Paragraph 5 (line 11). This step is shown with respect to steps 480 and 485 of Fig. 4 which is described in the specification on page 20, lines 7-10.

Claim 9, Paragraph 6 (line 12). This step is shown with respect to step 470 of Fig. 4 which is described in the specification on page 19, lines 13-23.

Claim 9, Paragraph 7 (lines 13-14). This step is shown with respect to Fig. 5 which is described in the specification on page 21, line 21 to page 22, line 10.

Claim 13. Claim 13 is directed to "[a] method of electronically presenting and paying paper-based bills for at least one customer having an account from which funds may be drawn." The method is primarily shown in Figs. 4 and as illustrated in the screenshots of Figs. 5-7, and discussed in the specification from page 21, line 21 to page 23, line 10, with the system used to implement the method being further shown in Figs. 2 and 3 and is discussed in the specification from page 14, line 18 to page 21, line 20.

Claim 13, Paragraph 1 (line 4). This step is described in the specification on page 16, lines 10-18 and with reference to Fig. 3.

Claim 13, Paragraph 2 (line 5). This step is shown with respect to step 415 of Fig. 4 which is described in the specification on page 18, lines 14-16.

Claim 13, Paragraph 3 (lines 6-7). This step is shown with respect to steps 425 and 440 of Fig. 4 which is described in the specification on page 18, lines 16-18.

Claim 13, Paragraph 4 (lines 8-11). This step is shown with respect to step 470 of Fig. 4 which is described in the specification on page 18, line 19 to page 19, line 4 and page 19, line 13 to page 20, line 6.

Claim 13, Paragraph 5 (line 12). This step is shown with respect to steps 480 and 485 of Fig. 4 which is described in the specification on page 20, lines 7-10.

Claim 13, Paragraph 6 (line 13). This step is shown with respect to step 470 of Fig. 4 which is described in the specification on page 19, lines 13-23.

Claim 13, Paragraph 7 (line 14). This step is shown with respect to step 490 of Fig. 4 which is described in the specification on page 19, lines 13-23.

Claim 13, Paragraph 8 (lines 15-16). This step is shown with respect to Fig. 5 which is described in the specification on page 21, line 21 to page 22, line 10.

Claim 13, Paragraph 9 (lines 17-18). This step is shown with respect to Figs. 3 and 7 and is described in the specification on page 23, lines 1-5 and page 21, lines 4-12.

Claim 13, Paragraph 10 (line 19). This step is shown with respect to Fig. 3 and is described in the specification on page 21, lines 11-12.

Claim 16. Claim 16 is directed to "[a] system for electronically presenting and paying bills for at least one customer having an account from which funds may be

drawn." The system is primarily shown in Figs. 2 and 3 and is discussed in the specification from page 14, line 18 to page 21, line 20, with the operation of the system being further shown in Figs. 4 and illustrated in the screenshots of Figs. 5-7, and discussed in the specification from page 21, line 21 to page 23, line 10.

Claim 16, Paragraph 1 (lines 3-4). This element is the Bill Center 200, the operation of which is described in the specification on page 15, lines 13-21 and with reference to Fig. 3.

Claim 16, Paragraph 2 (lines 5-7). This element is the Bill Center 200, the operation of which is described in the specification on page 18, lines 1-10 and with reference to Fig. 3.

Claim 16, Paragraph 3 (line 8). This element is the Bill Center 200, the operation of which is described in the specification on page 16, lines 10-18 and with reference to Fig. 3.

Claim 16, Paragraph 4 (lines 9-10). This element is the Bill Center 200, the operation of which is described in the specification on page 17, lines 9-23 and with reference to Fig. 3, and also with respect to step 410 of Fig. 4 which is described in the specification on page 18, lines 11-18.

Claim 16, Paragraph 5 (lines 11-12). This element is the scanner 350, the operation of which is shown with respect to steps 425 and 440 of Fig. 4 which is described in the specification on page 18, lines 16-18.

Claim 16, Paragraph 6 (line 13). This element is the Bill Center 200, the operation of which is shown with respect to step 470 of Fig. 4 which is described in the specification on page 18, line 19 to page 19, line 4 and page 19, line 13 to page 20, line 6.

Claim 16, Paragraph 7 (lines 14-15). This element is the Bill Center 200, the operation of which is shown with respect to steps 480 and 485 of Fig. 4 which is described in the specification on page 20, lines 7-10.

Claim 16, Paragraph 8 (lines 16-18). This element is the Bill Center 200, the operation of which is shown with respect to Fig. 5 which is described in the specification on page 21, line 21 to page 22, line 10.

Claim 24. Claim 24 is directed to "[a] system for electronically presenting and paying paper-based bills for at least one customer having an account from which funds may be drawn. The system is primarily shown in Figs. 2 and 3 and is discussed in the specification from page 14, line 18 to page 21, line 20, with the operation of the system being further shown in Figs. 4 and illustrated in the screenshots of Figs. 5-7, and discussed in the specification from page 21, line 21 to page 23, line 10.

Claim 24, Paragraph 1 (line 4). This element is the Bill Center 200, the operation of which is described in the specification on page 17, lines 9-23 and with reference to Fig. 3, and also with respect to step 410 of Fig. 4 which is described in the specification on page 18, lines 11-18.

Claim 24, Paragraph 2 (lines 5-6). This element is the scanner 350, the operation of which is shown with respect to steps 425 and 440 of Fig. 4 which is described in the specification on page 18, lines 16-18.

Claim 24, Paragraph 3 (line 7). This element is the Bill Center 200, the operation of which is shown with respect to steps 450 and 460 of Fig. 4 which is described in the specification on page 18, line 19 to page 19, line 12.

Claim 24, Paragraph 4 (lines 8-10). This element is the Bill Center 200, the operation of which is shown with respect to step 470 of Fig. 4 which is described in the specification on page 18, line 19 to page 19, line 4 and page 19, line 13 to page 20, line 6.

Claim 24, Paragraph 5 (lines 11-12). This element is the Bill Center 200, the operation of which is shown with respect to steps 480 and 485 of Fig. 4 which is described in the specification on page 20, lines 7-10.

Claim 24, Paragraph 6 (lines 13-14). This element is the Bill Center 200, the operation of which is shown with respect to Fig. 5 which is described in the specification on page 21, line 21 to page 22, line 10.

Claim 28. Claim 28 is directed to "[a] system for electronically presenting and paying paper-based bills for at least one customer having an account from which funds may be drawn." The system is primarily shown in Figs. 2 and 3 and is discussed in the specification from page 14, line 18 to page 21, line 20, with the operation of the system

being further shown in Figs. 4 and illustrated in the screenshots of Figs. 5-7, and discussed in the specification from page 21, line 21 to page 23, line 10.

Claim 28, Paragraph 1 (line 4). This element is the Bill Center 200, the operation of which is described in the specification on page 17, lines 9-23 and with reference to Fig. 3, and also with respect to step 410 of Fig. 4 which is described in the specification on page 18, lines 11-18.

Claim 28, Paragraph 2 (lines 5-6). This element is the scanner 350, the operation of which is shown with respect to steps 425 and 440 of Fig. 4 which is described in the specification on page 18, lines 16-18.

Claim 28, Paragraph 3 (line 7). This element is the Bill Center 200, the operation of which is shown with respect to steps 450 and 460 of Fig. 4 which is described in the specification on page 18, line 19 to page 19, line 12.

Claim 28, Paragraph 4 (lines 8-12). This element is the Bill Center 200, the operation of which is shown with respect to step 470 of Fig. 4 which is described in the specification on page 18, line 19 to page 19, line 4 and page 19, line 13 to page 20, line 6

Claim 28, Paragraph 5 (line 13). This element is the Bill Center 200, the operation of which is shown with respect to step 470 of Fig. 4 which is described in the specification on page 19, lines 13-23.

Claim 28, Paragraph 6 (lines 14-15). This element is the Bill Center 200, the operation of which is shown with respect to steps 480 and 485 of Fig. 4 which is described in the specification on page 20, lines 7-10.

Claim 28, Paragraph 7 (line 16). This element is the Bill Center 200, the operation of which is shown with respect to step 490 of Fig. 4 which is described in the specification on page 19, lines 13-23.

Claim 28, Paragraph 8 (lines 17-18). This element is the Bill Center 200, the operation of which is shown with respect to Fig. 5 which is described in the specification on page 21, line 21 to page 22, line 10.

Claim 28, Paragraph 9 (lines 19-20). This element is the Bill Center 200, the operation of which is shown with respect to Figs. 3 and 7 and is described in the specification on page 23, lines 1-5 and page 21, lines 4-12.

Claim 28, Paragraph 10 (lines 21-22). This element is the Bill Center 200, the operation of which is shown with respect to Fig. 3 and is described in the specification on page 21, lines 4-12.

VI. Grounds of Rejection to be Reviewed on Appeal

Claims 1-30 (including independent Claims 1, 9, 13, 16, 24, and 28) stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kolling et al. (U.S. Patent No. 5,963,925) in view of Krouse et al. (U.S. Patent No. 6,097,834).

For the purposes of discussion herein, each independent claim (Claims 1, 9, 13, 16, 24, and 28) will be argued separately, inasmuch as the invention of each such independent claim is separately and patentably distinguishable over the cited prior art.

VII. Argument

A. Summary of Arguments Presented on Appeal.

1. **The 35 U.S.C. § 103 Rejection Fails to Present a Prima Facie Case of Obviousness.** The October 20, 2005, Office Action does not provide a proper reason to make the combination of references made. It is well established that in order to establish a prima facie case of obviousness the Examiner must present evidence that would have led one of ordinary skill in the art to arrive at the claimed invention. In the obviousness rejections, the Examiner's rationale consists of the conclusory statement that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Krouse et al into the system of Kolling in order to facilitate the conversion of paper bills into an electronic format for presenting to a customer." Given that the Kolling et al. and Krouse et al. references are completely unrelated, this represents nothing more than using Appellants' claims as a shopping list for elements which are found in unrelated references. The Examiner suggests that "[t]he motivation would have been to encourage billers who are not yet ready to transmit electronic bills to the bill processors of Kolling to do so and also to facilitate the processing and/or conversion of paper bills to electronic bills." This reason

used to justify making the combination is illusory since the Krouse et al. system deals only with a walk-in bill payment terminal to allow a consumer to pay a bill, and not with bill presentment at all. Appellants submit that the Examiner has relied entirely upon Appellants' disclosure and teachings to supply that which is lacking in the applied prior art references. Accordingly, the rejection fails to present a prima facie case of obviousness and cannot be sustained.

2. The 35 U.S.C. § 103 Rejection Fails to Cite Art to Show Several Claim Limitations, Instead Alleging That These Limitations Are Obvious. The October 20, 2005, Office Action makes a number of allegations as to portions of the claims that are allegedly obvious without citing any prior art showing those limitations. Since the Examiner has not demonstrated any qualification as an expert in the field, this practice is absolutely impermissible as well as being indicative of the fact that the prior art indeed does not teach the claimed invention.

3. The 35 U.S.C. § 103 Rejection Fails to Teach the Inventions As Claimed. Each of independent Claims 1, 9, 13, 16, 24, and 28 includes multiple limitations which are not taught or suggested by any of the cited prior art references, either individually or in combination. In this regard, the October 20, 2005, Office Action substantially misrepresents what the cited references, particularly the Krouse et al. reference, teach. Since Claims 1, 9, 13, 16, 24, and 28 each include multiple limitations

which are not taught or suggested in the art, the rejection is deficient and cannot be sustained for this reason as well.

B. Brief Discussion of the References Cited. A brief review of the cited references is illustrative of the fact that while they each may contain one or more key words which are contained in Appellants' claims, they fail to teach Appellants' invention. Upon an examination of the cited references, it is apparent that they are concerned with issues which are completely unrelated to each other as well as being unrelated to Appellants' invention, and the only reason for combining them is that Appellants' claims teach a combination of elements some of which elements are present (but used for an unrelated purpose) in one or the other of the cited references. This use of the claimed invention as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art represents an impermissible use of hindsight.

1. The Kolling et al. Patent (U.S. Patent No. 5,963,925). The Kolling et al. patent is an electronic bill presentment system which is only capable of accepting electronic billing information from billers and presenting it electronically to consumers. The Kolling et al. reference simply does not work with paper bills, and does not use paper statements or invoices in any way; in fact, there is not a single word in the entire Kolling et al. reference which deals with the issue of paper bills. Rather, the Kolling et al. reference "replaces the preparation and mailing of paper statements and invoices from a biller with electronic delivery." Abstract, lines 1-2 (emphasis added).

The electronic statements, when displayed on the consumer's computer, have the same look as paper bills would have had (or formerly had).

2. **The Krouse et al. Patent (U.S. Patent No. 6,097,834).** The Krouse et al. reference is a walk-in bill payment system in which a customer brings a paper bill and physically walks into a location having a terminal for the walk-in bill payment system. As such, it is a completely manual bill payment system which is incapable of presenting bills to customers, and which is electronic only in that payment to the biller is made by the walk-in bill payment system through the ACH/EFT system. The customer must bring a paper bill to the facility having the walk-in bill payment system terminal. The bill is scanned by the walk-in bill payment system terminal and if the walk-in bill payment system has been set up to work with a bill from that particular biller (if the bill is recognized as a bill from a biller which is included the walk-in bill payment system's database) the customer is presented with a screen displaying the amount of the bill and the consumer is asked how the consumer proposes to make payment. In the Krouse et al. patent, the consumer uses a debit card, enters the PIN associated with the debit card, and the walk-in bill payment system debits the consumer's bank account which is tied to the debit card and electronically transmits payment to the biller. It is important to differentiate presentment from payment; the Krouse et al. patent deals solely with payment, and is completely incapable of presenting a bill electronically.

C. **The Rejection of Claims 1-30 (including independent Claims 1, 9, 13, 16, 24, and 28) under 35 U.S.C. Section 103(a) as being unpatentable over Kolling et al. (U.S. Patent No. 5,963,925) in combination with Krouse et al. (U.S. Patent No. 6,097,834) Fails to Present a Prima Facie Case of Obviousness.** In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Dir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). Such reason must stem from some teaching, suggestion, or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 22y

USPQ 657, 664, (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The statements made by the Examiner in the October 20, 2005, Office Action demonstrate the fact that the Examiner has used impermissible hindsight to make the combination of the Kolling et al. and Krouse et al. references: "Since Kolling deals with electronic statements which are financial documents, an ordinary skill artisan would have turned to the teachings of Krouse et al for these above noted teachings [the claim limitations not present in Kolling et al.]" October 20, 2005, Office Action, Page 6. In other words, since Reference A deals with Technology A, one of ordinary skill would have turned to the teachings of Reference B for the elements of the claims which Reference A does not include. This is absurd in the extreme, since there is absolutely no motivation whatsoever provided in this statement. The Examiner is essentially saying that it is obvious because it is obvious; without a doubt, this is the use of impermissible hindsight, using Appellants' claims as a blueprint to search for pieces in utterly unrelated prior art references.

Continuing, "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Krouse et al into the system

of Kolling in order to facilitate the conversion of paper bills into electronic format for presenting to a customer." October 20, 2005, Office Action, Page 6. What this is saying is that it would be obvious to incorporate Technology B of Reference B into the system of Reference A in order to do what the Examiner believes Technology B does, but doing it in the system of Reference A. This again is an implicit use of impermissible hindsight to provide elements missing from the primary reference from another unrelated reference without a single word as to why one skilled in the art would have done so.

Further, the Examiner has completely misinterpreted the Krouse et al. reference, since it does not "facilitate the conversion of paper bills into electronic format for presenting to a customer." Far from it -- the Krouse et al. reference only allows the recipient of a paper bill to take that paper bill and the recipient's debit card and physically walk into a store or business that has a terminal from the Krouse et al. walk-in bill payment system and pay the bill in that store or business using the debit card. Thus, the Krouse et al. system is not and indeed can not be part of a bill presentment system. It is a walk-in bill payment system which is completely unrelated to the electronic bill presentment system of Kolling et al. The October 20, 2005, Office Action completely mischaracterizes the nature of the Krouse et al. walk-in bill payment system, which teaches nothing which is even remotely relevant to an electronic bill presentment system. In the world of Krouse et al., bills are always presented to the customer in paper. In the world of Krouse et al., customers never access an electronic bill presentment and

payment system. Instead, in the world of Krouse et al., customers take their paper bills, travel to a store or business that has a Krouse et al. walk-in bill payment system, and pay their bill at the store or business with a debit card.

Appellants submit that one skilled in the art would have found absolutely no reason of any kind to combine the electronic bill-only bill presentment system of Kolling et al. with the walk-in bill paper bill payment system of Krouse et al. The October 20, 2005, Office Action failed to point to either a teaching in or an inference relating to either of the cited references which could lead one skilled in the art to combine them together. In point of fact, the references are completely unrelated and provide neither any teaching nor any suggestion, nor suggest any possible inference which could justify the combinations of references. At the conclusion of the Examiner's arguments, it is readily apparent that the obviousness rejection failed to meet even the most basic of the requirements established by the case law in pointing to any justification for making any of the combinations of references.

The bare recitation of references which are alleged (incorrectly) to disclose each of the elements of the claims in the October 20, 2005, Office Action without a proper reason that one skilled in the art would make the combination constitutes the use of hindsight and is per se improper. As stated by the Court of Appeals for the Federal Circuit, "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the

prior art to defeat patentability -- the essence of hindsight." In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). This clear and inappropriate use of hindsight knowledge to establish obviousness is impermissible, and the inescapable conclusion is that the obviousness rejection is an improper combination of prior art references, and is not sustainable. Accordingly, Appellants submit that the Section 103(a) rejections of Claims 1, 9, 13, 16, 24, and 28 must be withdrawn, and such withdrawal together with the allowance of independent Claim 1, 9, 13, 16, 24, and 28, as well as the claims depending therefrom, is respectfully solicited.

D. The Examiner's Unsupported Allegations That Several Claim Limitations Not Shown in the Cited References Are Without Proper Basis and Thus Fail to Comply With USPTO Requirements for a Rejection.

On Pages 5-6 of the October 20, 2005, Office Action, the Examiner repeatedly asserts that aspects of the claims are obvious without making any citation of prior art to support the allegations: "As per these limitations [the limitations of the independent claims which are not present in the Kolling et al. reference] the Examiner notes that transmitting or mailing paper bills to Kolling for further processing and presenting to a customer in an electronic format would have been obvious to one of ordinary skill in the art to do at the time of the invention. Nothing in Kolling prevents Kolling from accepting paper bills for conversion to electronic formats. . . . Thus, transmitting paper bills to the system of Kolling would have been readily acceptable through the regular mail system."

This is per se error on the part of the Examiner, and in view of this fact the rejections of the October 20, 2005, Office Action cannot stand. The Examiner has not established in any way that he is an expert in the field, and as such is absolutely unqualified to opine as to the obviousness of making modifications which are not taught in the art which has been cited by the Examiner. This is an unsupported assertion without a shred of documentation or other evidence, and constitutes a further indication that the rejection of Claims 1-30 is improper and must be removed.

Continuing, on Page 6 of the October 20, 2005, Office Action: "In so doing, Kolling would have scanned the received paper bills, do further image processing and cleaning the scanned paper bills which would have also been done for indexing and record keeping purposes. . . . These steps are well known in the art of image processing and analysis of scanned financial documents." This assertion is made without any statutory, regulatory, or M.P.E.P. basis whatsoever, particularly in view of the fact (which has been conceded on Page 5 of the October 20, 2005, Office Action) that the Kolling et al. reference does not receive, scan, work with, or otherwise use paper bills or any other paper documents in any way. This completely unsupported assertion in the October 20, 2005, Office Action is directly contravenes well-established U.S. Patent and Trademark Office procedures. Again, the Examiner has not in any way established an expertise in the field, and this thus represents an unsupported (and unsupportable)

modification of references which is inadequate to teach the invention as presently claimed.

Thus, Appellants assertion that the rejection of independent Claims 1, 9, 13, 16, 24, and 28 fails to teach all of the elements of these claims stands as being substantively unchallenged, and Appellants thus respectfully solicit the removal of the Section 103(a) rejections of Claims 1, 9, 13, 16, 24, and 28 on this ground, and the allowance of independent Claim 1, 9, 13, 16, 24, and 28, as well as the claims depending therefrom.

E. The Combination of References Cited in the 35 U.S.C. § 103(a) Rejection Does Not Teach the Claimed Invention. There are two separate errors in the Section 103(a) rejection in the October 20, 2005, Office Action based upon the Kolling et al. and Krouse et al. references. The first error is that both of these references are mischaracterized as teaching that which they quite simply do not in fact teach. The second is that the combination, even if it were a proper Section 103(a) combination rejection (which it is not), fails to teach no less than three of the elements of each of independent Claims 1, 9, 13, 16, 24, and 28.

1. The Cited References Have Been Mischaracterized as Teaching The Which They Do Not Fairly Teach.

With regard to the Kolling et al. reference, the October 20, 2005, Office Action contains a fundamental error relating to the word "template," with the Examiner asserting that Kolling et al. teaches "billing information . . . extracted using a predefined template."

October 20, 2005, Office Action, Page 5. While Kolling et al. uses the word "template," it is used with a completely different meaning than its meaning in the claims of the present application. Kolling et al. uses a data table referred to as a template for each biller, with each Kolling et al. template being nothing more than a list of the data fields which appear in a paper statement from that biller to the consumers which are its customers. Different billers have different data fields, and hence need different Kolling et al. templates. The batched electronic billing data for each biller is sorted for individual consumers, and the sorted batched electronic billing data is used to generate electronic billing statements, which are then sent to the appropriate consumers.

In stark contrast, the present patent application uses the word "template" as a description for the "zone information for locating the required billing summary data ... on the paper bill. . . . The required billing summary data zones include bill date, bill amount, minimum due, due date, account number and consumer name and address." Specification, page 19, line 13-15 and 18- 20, and Fig. 4. Thus, it is clear that the word "template" as used by Kolling et al. has a completely different meaning than the use of the word "template" in the present invention.

It is a long-standing and well-established rule that a patentee can be his or her own lexicographer, and as such it is clear that the word "template" as used in the claims of the present patent application is used in a completely different sense than the word "template" is used in the Kolling et al. reference. Thus, the reliance on the Kolling et al. reference to

teach a template library to identify the type of bill is baseless and incorrect at best, and it is in utter disregard of the readily apparent wide disparity in meanings occasioned by the use of the same word to describe completely different concepts. The plain fact is that the Kolling et al. reference does not teach what it has been asserted to teach in the October 20, 2005, Office Action.

With regard to the Krouse et al. reference, the October 20, 2005, Office Action has done far more than merely misconstrue the meaning of a single, albeit highly significant, word -- rather, the October 20, 2005, Office Action completely ignores the entire purpose, character, and operation of the Krouse et al. reference. The Krouse et al. reference has nothing whatsoever to do with electronic bill presentment, which is the subject of the claimed invention of the present patent application. The system of Krouse et al. is instead a walk-in bill payment system in which the customer always receives only a paper bill. In the system as claimed in the present invention, the customer gets only electronic bills. The Krouse et al. walk-in bill payment system requires the customer to physically travel to a store or business having a Krouse et al. walk-in bill payment system. The system of the present invention, of course, allows customers to receive and pay bills electronically from any location. The Krouse et al. walk-in bill payment system scans the bill and NEVER presents it electronically, in contrast to the system of the present invention, which presents the bill electronically. The Krouse et al. walk-in bill payment system displays the bill payment information on a monitor at the store or

business having a Krouse et al. walk-in bill payment system, and then requires the customer to enter debit card information and a PIN at the store or business. The plain fact is that the Krouse et al. is irrelevant to the claimed invention of the present patent application.

2. The Kolling et al. and Krouse et al. References Cited in the 35 U.S.C. § 103(a) Rejection Do Not Teach the Invention as Defined in Claims 1-30 (including independent Claims 1, 9, 13, 16, 24, and 28). The obviousness rejection is defective in that the references cited in the October 20, 2005, Office Action fail to teach all of the elements of Claims 1-30 (including independent Claims 1, 9, 13, 16, 24, and 28). In fact, each of these independent claims, which were rejected as obvious over the Kolling et al. and Krouse et al. references, has multiple limitations which are included in the claim language thereof which limitations are neither taught nor suggested in the Kolling et al. and Krouse et al. references.

a. The Kolling et al. and Krouse et al. References Do Not Teach Receiving At Least One Paper Bill for a Customer from a Biller. The limitation of receiving (or having means for receiving) at least one paper bill for a customer from a biller is present in each and every one of independent Claims 1, 9, 13, 16, 24, and 28:

Claim No.	Claim Limitation
1	"receiving at least one paper bill for said customer from at least one of said billers;"
9	"receiving and processing a paper bill for a customer;"
13	"receiving a paper bill for a customer;"
16	"means for receiving at least one paper-based bill for said customer from at least one of said billers;"
24	"means for receiving a paper bill for a customer;"
28	"means for receiving a paper bill for a customer;"

Krouse et al. can not receive paper bills for a customer from a biller.

(Kolling et al. does not work with or use paper bills in any way, but instead completely replaces such paper bills with electronic bills which are created from electronic information supplied by the billers to the BSP.) That specific limitation is present in each and every one of independent Claims 1, 9, 13, 16, 24, and 28.

Applicants assert that it is plain that the limitation of receiving (or having means for receiving) at least one paper bill for a customer from a biller, which is included in each and every one of independent Claims 1, 9, 13, 16, 24, and 28 is not taught or suggested in any of the references relied upon by the Examiner in the rejection under 35 U.S.C. Section 103(a). As such, the Section 103(a) rejection is erroneous, and Applicants respectfully request that it be withdrawn and that independent Claims 1, 9, 13, 16, 24, and 28, as well as the claims depending thereupon, be allowed.

b. The Kolling et al. and Krouse et al. References Do Not

Teach Scanning a Paper Bill to Generate Electronic Image Information. The

limitation of scanning a paper bill to generate electronic image information is present in each and every one of independent Claims 1, 9, 13, 16, 24, and 28:

Claim No.	Claim Limitation
1	"scanning said at least one paper bill received for said customer to generate electronic image information;"
9	"scanning said paper bill received for said customer to generate electronic image information,"
13	"scanning said paper bill received for a customer to generate electronic image information,"
16	"means for scanning said at least one paper bill received for said customer to generate electronic image information;"
24	"means for scanning said paper bill received for said customer to generate electronic image information;"
28	"means for scanning said paper bill received for said customer to generate electronic image information;"

Similarly, the limitation of scanning a paper bill which has been received (by the service provider) for a customer to generate electronic image information is present in each and every one of independent Claims 1, 9, 13, 16, 24, and 28 and is not taught by the cited references (while Krouse et al. may teach scanning a paper bill which is physically brought into a store or business having the Krouse et al. walk-in bill payment

system, it does not receive paper bills for customers and thus by definition cannot scan such bills).

Applicants assert that it is plain that the limitation of scanning a paper bill received for a customer to generate electronic image information, which is included in each and every one of independent Claims 1, 9, 13, 16, 24, and 28 is not taught or suggested in any of the references relied upon by the Examiner in the rejection under 35 U.S.C. Section 103(a). As such, it is apparent that that the Section 103(a) rejection of is erroneous and must be withdrawn, and Applicants respectfully request that independent Claims 1, 9, 13, 16, 24, and 28, as well as the claims depending thereupon, be allowed.

c. The Kolling et al. and Krouse et al. References Do Not Teach Validating the Billing Information Extracted from the Scanned Paper Bill.

The limitation of validating the billing information extracted from the scanned paper bill is present in each and every one of independent Claims 1, 9, 13, 16, 24, and 28:

Claim No.	Claim Limitation
1	"validating the extracted billing information generated from said scanned paper bill;"
9	"validating the extracted billing information generated from said scanned paper bill;"
13	"validating the extracted billing information generated from said scanned paper bill;"
16	"means for validating the extracted billing information generated from said scanned paper bill;"

24	"means for validating the extracted billing information generated from said scanned paper bill;"
28	"means for validating the extracted billing information generated from said scanned paper bill;"

The limitation of validating the billing information extracted from the scanned paper bill is also present in each and every one of independent Claims 1, 9, 13, 16, 24, and 28 and is not taught by the cited references. Applicants assert that it is plain that the limitation of validating the billing information extracted from the scanned paper bill, which is included in each and every one of independent Claims 1, 9, 13, 16, 24, and 28 is not taught or suggested in any of the references relied upon by the Examiner in the rejection under 35 U.S.C. Section 103(a). As such, it is apparent that that the Section 103(a) rejection is erroneous, and Applicants respectfully request that the rejection be withdrawn and that independent Claims 1, 9, 13, 16, 24, and 28, as well as the claims depending thereupon, be allowed.

For the simple reason that there are no less than three elements of each of independent Claims 1, 9, 13, 16, 24, and 28 that are not taught or suggested by the cited references, Applicants maintain that the combination of Kolling et al. and Krouse et al. does not teach the claimed invention. Claims 2-8, 10-12, 14, 15, 17-23, 25-27, 29, and 30, which are dependant claims, are all allowable as depending from allowable base claims, and contain further limitations which are not taught or suggested by the references (which will not be elaborated upon herein in view of the clear patentability of

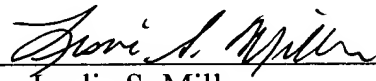
independent Claims 1, 9, 13, 16, 24, and 28). Claims 1-30 are patentable over the references cited in the October 20, 2005, Office Action, and the rejection must be withdrawn.

Conclusions

Independent Claims 1, 9, 13, 16, 24, and 28 of the present application are drafted in a manner which clearly defines them over the prior art. The Examiner's combination of references is an unsupportable example of hindsight-based obviousness. Further, several claim limitations were admittedly not shown by the cited prior art, but merely asserted to have been obvious without any support for that proposition. In addition, even could the combinations be made without the use of hindsight (which they cannot), they do not teach three elements of the claimed invention. Dependent Claims 2-8, 10-12, 14, 15, 17-23, 25-27, 29, and 30 depend upon the aforesaid independent claims, and thus are also believed to be allowable. Accordingly, Appellants believe the invention as presently claimed to be novel and nonobvious over the cited art and other art of which Appellants

are presently aware. Appellants accordingly respectfully request the removal of all rejections of pending Claims 1-30, and the allowance of the present application.

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VIII. Claims Appendix

1. (Original) A method of electronically presenting bills for at least one customer having an account from which funds may be drawn, comprising the steps of:

- allowing a customer to subscribe to a bill presentment system for receiving electronic-based and paper-based bills for said customer;
- notifying a plurality of billers that said customer has subscribed to said bill presentment system, said billers including electronic-based billers and paper-based billers;
- receiving at least one electronic bill for said customer from at least one of said billers;
- receiving at least one paper bill for said customer from at least one of said billers;
- identifying the contents of said paper bill;
- scanning said at least one paper bill received for said customer to generate electronic image information;
- identifying the type of bill;
- extracting billing information from said electronic image information, wherein the billing information is extracted using a predefined template;
- validating the extracted billing information generated from said scanned paper bill;
- and

19 presenting said at least one electronic bill and said extracted billing information
20 representative of said at least one paper bill to said customer.

1 2. (Original) The method of claim 1, further comprising the steps of:
2 removing unnecessary material from said received paper bill;
3 forwarding importance documents from said received paper bill to said customer;
4 receiving a payment instruction from said customer to pay a bill;
5 drafting a payment on an account for the customer account; and
6 sending the payment to the biller that originated the bill.

1 3. (Previously Presented) The method of claim 2, wherein step of drafting a payment
2 comprises the step of printing a physical check on said account.

1 4. (Original) The method of claim 3, further comprising the step of printing a stored
2 scanned image of a remittance stub.

1 5. (Previously Presented) The method of claim 2, wherein step of drafting a payment
2 comprises the step of submitting an electronic payment.

1 6. (Original) The method of claim 5, wherein step of drafting a payment comprises
2 the step of submitting an electronic payment using one of an automated clearing house
3 network, a automated teller machine network, and a credit card network.

1 7. (Previously Presented) The method of claim 1, wherein step of scanning further
2 comprises the steps of:
3 extracting billing information from said electronic image information using optical
4 character recognition, wherein the billing information is extracted using a predefined
5 template for the type of bill identified; and
6 extracting an image of the payment remittance stub from said paper bill.

1 8. (Original) The method of claim 1, further comprising the step of presenting an
2 electronic image of a paper bill upon receipt of a request from the customer.

1 9. (Original) A method of electronically presenting and paying paper-based bills for
2 at least one customer having an account from which funds may be drawn, comprising the
3 steps of:
4 receiving and processing a paper bill for a customer;
5 identifying the contents of said paper bill;
6 scanning said paper bill received for said customer to generate electronic image
7 information, wherein the type of bill is identified;

8 extracting billing information from said electronic image information using an
9 optical character recognition process, wherein the billing information is extracted using a
10 predefined template for the type of bill identified;
11 validating the extracted billing information generated from said scanned paper bill;
12 extracting an image of the payment remittance stub from said paper bill; and
13 presenting said extracted billing information representative of said at least one
14 paper bill to the customer.

1 10. (Original) The method of claim 9, wherein the type of bill is identified based upon
2 unique numeric identifiers contained within said paper bill.

1 11. (Original) The method of claim 9, further comprising the step of:
2 printing a physical check on an account of the customer.

1 12. (Original) The method of claim 11, further comprising the step of printing a stored
2 scanned image of a remittance stub.

1 13. (Original) A method of electronically presenting and paying paper-based bills for
2 at least one customer having an account from which funds may be drawn, comprising the
3 steps of:
4 receiving a paper bill for a customer;

5 identifying the contents of said paper bill;
6 scanning said paper bill received for a customer to generate electronic image
7 information, wherein the type of bill is identified;
8 extracting billing information from said electronic image information using an
9 optical character recognition process, wherein the billing information is extracted using a
10 predefined template for the type of bill identified, wherein each type of bill has an
11 associated template which contains zone information for locating the billing information;
12 validating the extracted billing information generated from said scanned paper bill;
13 extracting an image of a payment remittance stub from said paper bill;
14 storing said scanned image of said remittance stub for said paper bill;
15 presenting said extracted billing information representative of said paper bill to the
16 customer;
17 receiving a payment instruction from said customer to pay said paper bill; printing
18 a paper check on an account of the customer; and
19 printing said stored scanned image of said remittance stub for said paper bill.

1 14. (Original) The method of claim 13, wherein step extracting billing information is
2 performed automatically.

1 15. (Original) The method of claim 14, wherein step extracting billing information
2 comprises the steps of:

identifying a type of bill based upon unique numeric identifiers contained within
said paper bill; and

extracting billing information from zones that are pre-defined for said type of bill.

16. (Original) A system for electronically presenting and paying bills for at least one
customer having an account from which funds may be drawn, comprising:

means for allowing a customer to subscribe to a bill presentment system for
receiving electronic and paper-based bills for said customer;

means for notifying a plurality of billers that said customer has subscribed to said
bill presentment system, said billers includes electronic-based billers and paper-based
billers;

means for receiving at least one electronic bill for said customer;

means for receiving at least one paper-based bill for said customer from at least
one of said billers;

means for scanning said at least one paper bill received for said customer to
generate electronic image information;

means for extracting billing information from said electronic image information;

means for validating the extracted billing information generated from said scanned
paper bill; and

16 means for transmitting information that enables said customer to view at least one
17 electronic bill and said extracted billing information representative of said at least one
18 paper bill to said customer.

1 17. (Original) The system of claim 16, further comprising:

2 means for receiving a payment instruction from said customer to pay a bill;

3 means for drafting a payment on an account for the customer; and

4 means for sending the payment to the billing that originated the bill.

1 18. (Original) The system of claim 17, wherein said means for drafting comprises

2 means for printing a physical check on said account.

1 19. (Original) The system of claim 18, wherein said means for printing also prints a

2 stored scanned image of a remittance stub.

1 20. (Original) The system of claim 17, wherein said means for drafting comprises

2 means for submitting an electronic payment.

1 21. (Original) The system of claim 20, wherein said means for submitting submits an

2 electronic payment using one of an automated clearing house network, a automated teller

3 machine network, and a credit card network.

22. (Original) The system of claim 16, wherein said means for extracting extracts billing information from said electronic image information using optical character recognition.

23. (Original) The system of claim 16, wherein said means for transmitting transmits an electronic image of a paper bill upon receipt of a request from the customer.

24. (Previously Presented) A system for electronically presenting and paying paper-based bills for at least one customer having an account from which funds may be drawn, comprising:

means for receiving a paper bill for a customer;

means for scanning said paper bill received for said customer to generate electronic image information;

means for identifying the type of bill;

means for extracting billing information from said electronic image information using optical character recognition, wherein the billing information is extracted using a predefined template for the type of bill identified;

means for validating the extracted billing information generated from said scanned paper bill; and

means for transmitting said extracted billing information representative of said at least one paper bill to said customer.

1 25. (Original) The system of claim 24, wherein said means for extracting comprises:
2 means for identifying a type of bill based upon unique numeric identifiers
3 contained within said paper bill; and
4 means for extracting billing information from zones that are pre-defined for said
5 type of bill.

1 26. (Original) The system of claim 24, further comprising means for printing a
2 physical check on an account of the customer.

1 27. (Original) The system of claim 26, wherein said means for printing also prints a
2 stored scanned image of a remittance stub.

1 28. (Previously Presented) A system for electronically presenting and paying paper-
2 based bills for at least one customer having an account from which funds may be drawn,
3 comprising:

4 means for receiving a paper bill for a customer;

5 means for scanning said paper bill received for said customer to generate
6 electronic image information;

7 means for identifying the type of bill;

8 means for extracting billing information from said electronic image information
9 using an optical character recognition process, wherein the billing information is

10 extracted using a predefined template for the type of bill identified, wherein each type of
11 bill has an associated template which contains zone information for locating the billing
12 information;

13 means for extracting an image of a payment remittance stub from said paper bill;

14 means for validating the extracted billing information generated from said scanned
15 paper bill;

16 means for storing a scanned image of said remittance stub for said paper bill;

17 means for transmitting said extracted billing information representative of said
18 paper bill to the customer;

19 means for receiving a payment instruction from said customer to pay said paper
20 bill; and

21 means for printing a paper check on an account of the customer and said stored
22 scanned image of said remittance stub for said paper bill.

1 29. (Original) The system of claim 28, wherein said means for extracting operates
2 automatically.

1 30. (Original) The system of claim 29, wherein said means for extracting comprises:
2 means for identifying a type of bill based upon unique numeric identifiers
3 contained within said paper bill.

IX. Evidence Appendix

None.

X. Related Proceedings Appendix

None.